

REMARKS

Applicant respectfully requests reconsideration of this application. No claims have been canceled. Claims 28, 31 and 33-35 have been amended to more properly define preexisting claim limitations and are supported by the specification.

Rejections Under 35 U.S.C. § 103(a)

Claims 28 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,078 of Menelli et al. ("Menelli") in view of U.S. Patent No. 5,734, 706 of Windsor ("Windsor").

Applicant respectfully submits that the Office Action does not properly communicate the basis for rejection to claim 28. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. [MPEP §706.02(j), MPEP §706]. The Office Action fails to set forth "the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate." [MPEP §706.02(j)]. Specifically, Applicant respectfully submits that the Office Action fails to show where the prior art (or references) teach or suggest a machine-readable medium having instructions to cause a machine to perform a method, the method comprising the elements, as claimed, including the element of "updating the pre-existing address book entry with the new phone number upon determining the new phone number does not match the pre-existing phone number," as recited in claim 28. [MPEP §706.02(j)]. Accordingly, Applicant respectfully requests reexamination of this application.

Nonetheless, upon review of the cited sections of Menelli and Windsor without reference to the claim elements, Applicant respectfully submits that the combination of Menelli and Windsor does not disclose or suggest each and every element as recited in claim 28. Specifically, the combination does not disclose or suggest the element of “updating the pre-existing address book entry with the new phone number upon determining the new phone number does not match the pre-existing phone number.”

Applicant submits that Menelli appears to simply disclose that a device may store call information in an expense data store, which is not the same as updating the address book with a new phone number associated with a contact. Specifically, the section cited in the above-referenced Office Action cites a process *to extract* a name and category from an address book record or entry that matches a call. (See Menelli, column 5, lines 50-66). This extracted information is used to add detail to the expense data store. However, Menelli does not disclose or suggest that the address book entry will be updated with any information, much less a phone number. This is because the motivation of Menelli is not to update the address book but to build the expense data store.

In addition, Windsor does not cure the deficiency of Menelli by failing to disclose and suggest “updating the pre-existing address book entry with the new phone number upon determining the new phone number does not match the pre-existing phone number,” as claimed. Rather, Windsor discloses that a phone log will automatically populate information into a database and missing information is secured and *populated from* the attached relational database called the client records, when such client records exist. (See Windsor, column 9, lines 25-30). Therefore, it appears that, similar to Menelli, Windsor adds a record to a phone log after receiving additional information from a client record.

Therefore, the combination does not disclose or suggest that the preexisting client record is updated upon determining the new phone number does not match the pre-existing phone number. Updating the address book, as claimed, prevents entries in the address book from becoming stale when a contact, for example, switches mobile phone numbers, starts a new job, moves to a new house, etc.

Accordingly, Applicant respectfully submits that the combination of Menelli and Windsor do not disclose or suggest each and every element of claim 28. Claim 30 is dependent on claim 28. Therefore, Applicant respectfully requests the rejection to claims 28 and 30 be withdrawn under 35 USC §103(a).

Claims 31-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,078 of Menelli et al. (“Menelli”) in view of U.S. Patent No. 5,734,706 of Windsor (“Windsor”) and further in view of U.S. Patent No. 6,473,496 of Mohageg (“Mohageg”).

As articulated above, claim 28 is patentable over Menelli and Windsor. Mohageg fails to cure the deficiency of the combination of Menelli and Windsor including the failure to disclose or suggest “updating the pre-existing address book entry with the new phone number upon determining the new phone number does not match the pre-existing phone number,” as recited in claim 28. Claims 31-37 are dependent (directly or indirectly) on claim 28 and therefore are patentable, at least, for the reasons stated above for claim 28. Accordingly, Applicant respectfully submits that the combination of Menelli, Windsor, and Mohageg does not disclose or suggest each and every element as claimed. Therefore, Applicant respectfully requests the rejection to claims 31-37 under 35 USC §103(a) be withdrawn.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,078 of Menelli et al. (“Menelli”) in view of U.S. Patent No. 5,734,706 of Windsor (“Windsor”) and further in view of U.S. Patent No. 6,397,060 of Oikawa (“Oikawa”) or U.S. Patent No. 6,449,360 of Utsumi (“Utsumi”) or U.S. Patent No. 5,894,507 of Hatamura (“Hatamura”).

As articulated above, claim 28 is patentable over Menelli and Windsor. Oikawa, Utsumi, and Hatamura fail to cure the deficiency of the combination of Menelli and Windsor including the failure to disclose or suggest “updating the pre-existing address book entry with the new phone number upon determining the new phone number does not match the pre-existing phone number,” as recited in claim 28. The above-referenced Office Action states “Hatamura teaches a communication device wherein a number can be replaced with another number in (see claim 42).” However, Applicant respectfully submits that Hatamura does not recite a claim 42. Claim 33 is dependent on claim 28 and therefore is patentable, at least, for the reasons stated above for claim 28. Accordingly, Applicant respectfully submits that the combination of Menelli, Windsor, Oikawa, Utsumi, and Hatamura does not disclose or suggest each and every element as claimed. Therefore, Applicant respectfully requests the rejection to claims 33 under 35 USC §103(a) be withdrawn.

CONCLUSION

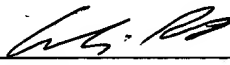
Applicant respectfully submits that the rejections have been overcome by the amendments and remarks, and that the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests the rejections be withdrawn and the pending claims be allowed.

If there are any additional charges, please charge Deposit Account No. 02-2666 for any fee deficiency that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: July 12004


André Gibbs
Reg. No. 47,593

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300